

Peter Gibson, Reg. #34,605
6316 Greenspring Ave, #307
Baltimore, MD 21209 USA

Commissioner of Patents
Washington, D.C. 20231

Art Unit: 2165
Facsimile: 703/746-7239

Examiner: James H. Zurita

Re: Application No. 09/543,764
Applicant: John L. Howes

15 April 2002

Dear Sir/Madam,

Following please find the below described materials relating to the above identified application for utility patent in response to the first Office action dated 15 January 2002:

- | | | |
|-------------------|---|------------|
| 1. | Letter of Transmittal including Certificate of Transmission on: | 1 sheet; |
| 2. | Applicant's Response to First Office Action on: | 24 sheets; |
| 3. | Amendment A - Marked-Up Version on: | 17 sheets; |
| 4. | Amendment A - Clean Version on: | 16 sheets; |
| Total: 58 sheets. | | |

Please file the above described materials in the above identified application for patent. Thank you kindly for your service.

Respectfully yours,

Peter Gibson, Reg. #34,605
Tel. 410/358-5912; Fax -9636

CERTIFICATE OF TRANSMISSION

I, Peter Gibson, Reg. #34,605, Agent of Record in Application No. 09/543,764, do hereby attest to facsimile transmission of the above identified materials on 58 sheets total in response to the first Office action in said application on April 15th 2002 to Facsimile Number: 703/746-7239.

Peter Gibson, Reg. #34,605

April 15th 2002

#7A
4/19/02

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION**A. Acknowledgment of Action***Information Disclosure Statement*

1. Applicant respectfully acknowledges Examiner's consideration of the "Prior Art listed in both the application and the Petition to Make Special" and citation of references on PTO form 892.

*Objection to the Specification*

2. Applicant respectfully acknowledges: Examiner's objection to the specification because of a number of informalities believed to be "word processing errors"; Examiner's encouragement "to review the application for similar errors"; requirement of correction; and Examiner's identification, correction, and application of the corrections in fourteen instances of informality for purposes of examination.

Claim Rejections - 35 USC § 112

3. Applicant respectfully acknowledges: Examiner's citation of the second paragraph of 35 U.S.C. 112 and requirement of "appropriate correction" in six identified instances of indefinite language in the claims; Examiners encouragement "to review the application for similar errors"; and Examiner's identification, correction, and application of the corrections in said six instances for purposes of examination.

Claim Rejections - 35 USC § 103

4. Applicant respectfully acknowledges Examiner's citation of 35 U.S.C. 103(a) as "the basis for all obviousness rejections set forth in this Office action" and rejection of claim 1 under 35 U.S.C. 103(a) "as being unpatentable over a publication entitled Web Ordering May Alter Role of Distributors ... herein after referred to as DISTRIBUTOR ROLES" because "(a)s per claim 1, Distributor Roles discloses the (present claim 1 recited verbatim except for the apparently inadvertent hyphenation in line 16 of 'assemblage-as')" followed by:

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

See page 3, *The future that's already here* describing placing orders for home improvement products (including Electronic Internet customer ordering of tools, lumber and other building materials) from distributors and manufacturers, entering data and producing product details (page 3, paragraph 12), and home improvement distributor applications. Page 3, line 2, describing product assembly; page 3, paragraph 5 include the bulkiest home improvement products. Page 3, paragraph 1, describing that orders may be taken electronically and shipped directly from manufacturers to consumers; page 3, paragraph 4, describing drop-shipment; page 4, *Delivering the Goods*)

DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings. While DISTRIBUTOR ROLES discloses a customer order subsystem, the article does not specifically detail said subsystem.

Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to disclose ordering, production, packaging and delivery of liquid coatings. It would also have been obvious to one of ordinary skill in the art to describe the components of a customer order subsystem.

One of ordinary skill in the art at the time the invention was made would have been motivated to disclose ordering, production, packaging and delivery of liquid coatings for the obvious reason that liquid coatings are another type of product that is in great demand by customers for home improvements and home building. One of ordinary skill in the art at the time the invention was made would also have been motivated to include the components of a customer order subsystems for the obvious reason that customer order entry systems and subsystems have been used for many years and said customer order entry systems and subsystems make it possible for customers to enter orders and participate in electronic commerce.

Besides liquid coatings, hardware stores and home improvement retailers (e.g., HOME DEPOT, LOWE'S) often sell the following products ... sold by volume, by unit, by weight, or by length, as applicable.

Liquid coatings are often found side by side with other home improvement products. Many lumber products are best used with liquid coatings. Liquid coatings are often delivered to job sites and customer addresses.

One of ordinary skill ... would know that by including liquid coatings among their products and service, distributors provide ordering convenience and lower priced products ... (and) would also benefit from becoming electronic clearinghouses. Distributors would cut their operational costs since they would not have to receive, store and ship product orders without the need to do so. Distributors would have no need to maintain an inventory, which would include standard and non-standard volumes and standard and non-standard colors of liquid coatings. Distributors provide the economic benefit of just-in-time inventory, which reduces inventory costs

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

to customers. (FOA, page 7, last paragraph through page 9, penultimate paragraph)

5. Applicant respectfully acknowledges Examiner's rejection of claims 2 and 3 and the reasons given in support thereof:

As per claims 2 and 3, DISTRIBUTOR ROLES discloses electronic commerce in home improvement products.

DISTRIBUTOR ROLES does not disclose that home improvement products may include liquid coating products ...

... one (of) ordinary skill in the art would know to disclose that liquid products are containerized in standard volume containers and that fulfillment of a customer order may include partially filling one of the standard volume containers. (FOA page 9, last paragraph through page 11, first paragraph)

6. Applicant respectfully acknowledges Examiner's rejection of claims 4-6 and the reasons given in support thereof:

As per claims 4-6, DISTRIBUTOR ROLES discloses the method of claim 1 for home improvement products. DISTRIBUTOR ROLES does not disclose that the liquid product is containerized in non-standard volume expansible containers, that the expansible containers are of molded plastic construction and the expansible containers possess a collar about an aperture whose collar is gripped during operation of the production line.

Nevertheless, it would have been obvious ... to disclose that the liquid product is containerized in non-standard volume expansible containers, that the expansible containers are of molded plastic construction and the expansible containers possess a collar about an aperture whose collar is gripped during operation of the production line.

One of ordinary skill ... would have been motivated to disclose that the liquid product is containerized in non-standard volume expansible containers, that the expansible containers are of molded plastic construction and the expansible containers possess a collar about an aperture whose collar is gripped during operation of the production line for the obvious reason that manufacture and distribution of many liquid coating products is often regulated by government entities ... (which) dictate

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

requirements for storage, transportation and delivery (of) liquid coating products (and) may determine what products fall within their definitions of hazardous materials (and) may regulate that some liquid coating products must be transported in metal containers ... density of the plastic containers, the chemical composition ...

One of ordinary skill in the art would know that higher volumes may require sturdier containers ... thicker plastic containers would weigh more than thinner plastic containers. Collapsible plastic containers would most likely weigh less than rigid walled plastic containers.

One of ordinary skill in the art would know that bottling a liquid is best accomplished by filling the container through an aperture that is simultaneously held by a gripping mechanism ... gripping a container by a collar facilitates placement of a sealing top on the container.

It would be obvious ... to use collapsible plastic containers ... (to) spend less money ... (l)ower production costs ... and allow for better utilization of natural resources (which) also permits less contamination and provides everyone on the planet with a healthier environment. (FOA page 11, second paragraph through page 13, second paragraph)

7. Applicant respectfully acknowledges Examiner's rejection of claims 7-10 and the reasons given in support thereof:

As per claims 7-10, DISTRIBUTOR ROLES discloses the methods (sic) of claim 1 of identifying products for assembly and delivery (page 3, paragraph 1, describing that orders may be taken electronically and shipped directly from manufacturers to consumers; page 3, paragraph 4, describing drop-shipment; page 4, *Delivering the Goods*).

DISTRIBUTOR ROLES does not disclose which data is selected for print on the label of a container. DISTRIBUTOR ROLES does not use the words 'digital code readable by a scanner.' DISTRIBUTOR ROLES does not specifically state that the information on a container may include at least one of the group comprised of color of liquid coating product, customer name, delivery date, quantity of product in order, number of containers for each liquid coating product in the order.

Nevertheless, it would have obvious ... to select data for placing on a container ... to include bar code(s), text and images on a container's label, and to include at least one of the group comprised of color of liquid coating product, customer name, delivery date, quantity of product in order, number of containers for

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

each liquid coating product in the order.

One of ordinary skill ... would have been motivated to select data for placing on a container as an identifying label, to include bar code(s) text and images on a container's label, and to include at least one of the group comprised of color of liquid coating product, customer name, delivery date, quantity of product in order, number of containers for each liquid coating product in the order for the obvious reason that the methods and technology for using bar codes have existed for several decades for process and inventory control (in supermarkets, for example). The technology has also been very successful for delivery of packages and letters (for example, U.S. Postal Service, UNITED PARCEL POST, FEDERAL EXPRESS). Barcode application have long been used in product manufacture (for example, on containers of COCA COLA).

In order to deliver a product, the package or container normally has information as to where the item is to be sent (including) location ... name of the recipient ... delivery date, total number of containers in the shipment, content information etc. To speed up and save money during production, bar codes and bar code labels can hold information as to where a container is in a manufacturing product line. One would want to automate the method of identifying different containers and processing steps for the obvious reason that it avoids confusion, permits machines to more efficiently read and process information concerning the container and its contents. (FOA page 13 penultimate paragraph through page 15 first paragraph)

8. Applicant respectfully acknowledges Examiner's rejection of claims 11-16 and the reasons given in support thereof:

As per claims 11-16, DISTRIBUTOR ROLES discloses that home improvement products may be sold in bulk from a manufacturer to a distributor, and even from a manufacturer to a customer, for example, a construction contractor at his job sites (page 3, paragraph 1, describing that orders may be taken electronically and shipped directly from manufacturers to consumers; page 3, paragraph 4, describing drop shipment; page 4, *Delivering the Goods*). Home improvement products include liquid coating products.

DISTRIBUTOR ROLES does not specifically describe the process of adding blended liquid coating base to an empty container. While DISTRIBUTOR ROLES discloses that manufacturers may ship liquid home improvement products directly to distributors and customers in containers, DISTRIBUTOR ROLES does not

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

specifically mention 55-gallon barrels or railroad tank cars (as in claim 12). DISTRIBUTOR ROLES does not describe that the liquid product is transferred from a manufacturer's container to a tank for dispensing said liquid (as in claim 13). DISTRIBUTOR ROLES does not describe steps for identifying the type of liquid coating base added upon the container (claim 14), adding colorant to the blended liquid coating base (claim 15) and identifying the resulting color (claim 16).

Nevertheless, it would have been obvious ... to disclose that manufacturers may ship ... in 55-gallon barrels or railroad tank cars (as in claim 12). It would have been obvious ... to describe that the liquid product is transferred from a manufacturer's container to a tank for dispensing said liquid (as in claim 13). It would have been obvious ... to include steps for identifying the type of liquid coating base added upon the container (claim 14), adding colorant to the blended liquid coating base (claim 15) and identifying the resulting color (claim 16).

One of ordinary skill ... would have been motivated to disclose that manufacturers may ship liquid home improvement products directly to distributors and customers in 55-gallon barrels or railroad tank cars (as in claim 12) for the obvious reason that bulk purchases from a manufacturer may lower the overall costs of producing goods ... save money ... creating jobs and financial opportunities.

One of ordinary skill ... would have been motivated to disclose that a liquid product may be transferred ... (as in claim 13) for the obvious reason that raw materials must be integrated into a manufacturing process ... While terms of product delivery will vary by industry, offloading a railroad tank, for example, could mean that railroad tank may be leased ... (realizing) savings (that) can be used to improve marketing, or may be passed directly to customers.

One of ordinary skill ... would have been motivated to disclose steps for identifying the type of liquid coating base (claim 15) and identifying the resulting color (claim 16) for the obvious reason that in a manufacturing process that includes blending and mixing different products ... it would be very bad to send him water-based indoor non-standard variations of an unordered different color. (FOA page 15, second paragraph through page 18, first paragraph)

9. Applicant respectfully acknowledges Examiner's rejection of claims 17-22 and the reasons given in support thereof:

As per claims 17-22, DISTRIBUTOR ROLES discloses that orders from a customer to a supplier may be placed via telecommunications (as in claim 17), with

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

the use of a telephone connected to a public telephone exchange (as in claim 18), via facsimile transmission (as in claim 20) (page 1, paragraph 3, page 3, paragraph 11). As in claim 19, DISTRIBUTOR ROLES also discloses that supplier personnel may enter customer orders into a customer order subsystem (page 3, paragraph 11).

While DISTRIBUTOR ROLES discloses the use of a customer order subsystem and a production subsystem, DISTRIBUTOR ROLES does not disclose that the customer order subsystem and the production subsystem are both maintained on the same computer (as in claim 21). DISTRIBUTOR ROLES does not disclose that the customer order subsystem is maintained on one computer and the production subsystem is maintained on a different computer (as in claim 22).

Nevertheless, it would have been obvious to one of ordinary skill in the art to place the customer order subsystem and a production subsystem on separate computers, as well as to place the two subsystems on the same computer.

One of ordinary skill in the art would have been motivated to place the customer order subsystem and a production subsystem on separate computers, as well as to place the two subsystems on the same computer for the obvious reason that when designing client/server systems, both system architectures present valid, useful and safe alternatives. One of ordinary skill in the art would have known that co-locating the two subsystems would be safer ... that Internet commerce includes digital certificates ... that ... made it safer to co-locate subsystems on a single physical computer ... that placing the subsystems on different ... computers may allow (greater efficiency) ... It may also make sense ... for different workloads. (FOA page 18, second paragraph through page 19)

10. Applicant respectfully acknowledges Examiner's rejection of claims 23-24 and the reasons given in support thereof:

As per claims 23-24, DISTRIBUTOR ROLES discloses that the step of placing an order by a customer directly with a remote supplier of liquid coating product is conducted with the use of the Internet (DISTRIBUTOR ROLES, page 2, paragraphs 8, 9 describing that customers may use an Internet-wired kiosk, place an order with a distributor, and the distributor would ship the ordered product to a customer's home). DISTRIBUTOR ROLES does not disclose the use of a [portable] Internet device (as in claim 24).

Nevertheless, it would have been obvious to one of ordinary skill in the art to include the use of portable internet devices as part of (an) electronic commerce

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

customer order system.

One of ordinary skill in the art would have been motivated to include the use of portable internet devices as part of (an) electronic commerce customer order system for the obvious reason that these devices are readily available ... portable devices have long included PALM Personal Digital Assistants ... Thus, it would be obvious to utilize the devices' design to connect customers to the Internet ... (to) contribute to the overall economy. (FOA page 20 first through third paragraphs)

11. Applicant respectfully acknowledges Examiner's rejection of claims 25-28 and the reasons given in support thereof:

As per claims 25-28, DISTRIBUTOR ROLES discloses the method of claim 24 ... (Page 2, paragraph 8, describing an Internet kiosk).

While DISTRIBUTOR ROLES discloses the use of customer orders and production, DISTRIBUTOR ROLES does not disclose that the step of entering customer orders into a customer order subsystem is accomplished by the computer maintaining the customer order subsystem (as in claim 26). DISTRIBUTOR ROLES does not disclose that the customer order subsystem and the production subsystem are both maintained on the same computer (as in claim 27). DISTRIBUTOR ROLES does not disclose that the customer order subsystem is maintained on one computer and the production subsystem is maintained on a different computer (as in claim 28).

Nevertheless, it would have been obvious to one of ordinary skill in the art to place the customer order subsystem and a production subsystem on separate computers, as well as to place the two subsystems on the same computer.

One of ordinary skill in the art would have been motivated ... for the obvious reason that when designing client/server systems, both architectures present valid, useful and safe alternatives ... In the absence of other factors, it may be fastest to enter customer data into the same computer that maintains the customer order subsystem. (FOA page 20, last paragraph through page 22 first paragraph)

12. Applicant respectfully acknowledges Examiner's rejection of claims 29-34 and the reasons given in support thereof:

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000**APPLICANT'S RESPONSE TO FIRST OFFICE ACTION**

of the examination:

- a. Page 23, line 17: *consumer 11* has been changed to *consumer 10*;
- b. Page 24, lines 1, 6, 11 & 20: *consumer 11* has been changed to *consumer 10*;
- c. Page 24, lines 21 & 25: *modem connection 12* has been changed to *modem connection 13*;
- d. Page 25, line 1: *consumer 19* has been changed to *consumer 10*;
- e. Page 25, line 3: *liquid coating product 26* has been changed to *liquid coating product 36*;
- f. *NB* Page 26, lines 10 & 18: *consumer 11* has been changed to *consumer 10*;
- g. Page 26, line 22: now reads *and the number of containers 23 utilized in fulfillment of each order*;
- h. Page 27, line 1: *shipping 30* has been changed to *shipping 27*;
- i. Page 28, line 25: *production subsystem 20* has been changed to *production subsystem 21*;
- j. Page 29, lines 8-9: *production subsystem 20* has been changed to *customer order subsystem 20*;
- k. Page 29, line 22: *the number of different liquid coating products 26 comprising the order* has been changed to *the number of different containerized liquid coating products 36 comprising the order*;
- l. Page 29, line 23: *a bar or other code 51* has been changed to *a bar or other digital code 52*;
- m. Page 29, line 25: *a bar or other code 51* has been changed to *a bar or other digital code 52*;
- n. Page 30, lines 22-23: *would largely the economy* has been changed to *would largely -negate- the economy*.

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

2. Applicant respectfully submits that the specification has been carefully reviewed for other informalities and correction of the same is effected by Amendment A attached hereto.

Claim Objections/Rejections - 35 USC § 112

3. Applicant respectfully submits that Amendment A, attached hereto, overcomes the objections/rejections to present claims 1, 2, 3, 4, 5, 6, 10, 16, 21, 22, 28, 29 & 34 under 35 U.S.C. 112 in correction in accordance with requirement conveyed in the first Office action of the six terms identified by Examiner as indefinite:

- a. the term 'superior to' in the phrase "a precision in the addition of colorant to liquid coating base superior to the precision readily obtainable by a conventional local retailer (claim 1, lines 13 - 14) has been replaced by 'exceeding', and the term 'superior consistency with regard to' (claim 1, lines 21 - 22) has been deleted;
- b. the term 'standard volume' has been replaced by 'rigid metal' in qualification of 'container' in claims 2, and 3.
- c. the term 'non-standard' in claims 1, 29, 34 and through out the specification has been replaced by the term 'custom' in qualification of 'a particular color' and the word 'may' has been deleted from the relevant passages defining this term in the specification: "which [may] requires the addition of colorant in order to achieve a particular, [non-standard] custom, color" (page 21, lines 3 - 4); "containerized liquid covering product 36 which [may] requires colorant addition to achieve any one of a plurality of particular, [non-standard] custom, colors" (page 21, last three lines of first paragraph); and 'containerized liquid coating product including that which [may] requires colorant addition to achieve a particular, [non-standard] custom, color which is conventionally available only form a local retailer and which is unavailable from the manufacturer of such product.' (page 21, second through fourth lines of the second paragraph);

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

- d. the term 'color' in claim 10 has been changed to 'color name' in the phrase "color name of liquid coating product";
- e. the term 'color' in claim 16 has been changed to 'name of the color' in the phrase "identifying the name of the color resulting";
- f. "with a production subsystem" has been added (claim 1, line 10) to establish proper antecedent basis for "said production subsystem" (claim 1, line 11) and "the production subsystem" in claims 21, 22, and 28.

Claim Rejections - 35 USC § 103

- 4. Applicant respectfully submits that Examiner is on record in the first Office action as stating that: "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph).
- 5. Applicant respectfully submits that Examiner's fundamental reason given in support of rejection of present claim 1 under 35 U.S.C. 103 is that:

One of ordinary skill in the art at the time the invention was made would have been motivated to disclose ordering, production, packaging and delivery of liquid coatings for the obvious reason that liquid coatings are another type of product that is in great demand by customers for home improvements and home building. (FOA, page 8 fourth paragraph)

- 6. Applicant respectfully submits that there is no suggestion of 'ordering, production, packaging and delivery of liquid coatings' in the prior art cited in the first Office action; that Examiner's statement "that liquid coatings are another type of product that is in great demand by customers for home improvements and home building" fails to comprise evidence of any suggestion in the prior art of 'ordering, production, packaging and delivery of liquid coatings'.

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

7. Applicant respectfully submits that Examiner's statement that "hardware stores and home improvement retailers" sell a variety of products including paints and other liquid coatings is unsupportive of rejection of the presently claimed invention because it fails to present evidence that the prior art discloses, suggests, or otherwise renders said invention obvious in view of the prior art.
8. Applicant respectfully submits that Examiner's statement that one of ordinary skill in the art "would know that by including liquid coatings among their products and services" as providing certain benefits constitutes a statement in support of the unobviousness of the presently claimed invention because if one 'would know' that inclusion of liquid coatings among their products, presumably sold in accordance with a method similar to that presently claimed, would provide benefit then there are only two reasons this wasn't disclosed by the prior art: it was either unknown at the time or the means of accomplishing it were unknown; and hence the presently claimed invention, for the "ordering, production, packaging and delivery of liquid coatings", which by Examiner's own admission is not disclosed by the prior art, was certainly novel at the time of invention because one of ordinary skill in the art 'would know' that the presently claimed method for liquid coating product would be beneficial and therefor used or disclosed if known or obvious.
9. Applicant respectfully submits that Examiner states that the only reference cited in rejection of the presently claimed invention under 35 U.S.C. 103 "does not disclose that home improvement products may include liquid coating products" (FOA, page 10, first paragraph).
10. Applicant respectfully submits that the grounds of rejection of claim conveyed in Examiner's statement that one of ordinary skill:

"would have been motivated to disclose that home improvement products may include liquid coating products and that the liquid products are containerized in standard volume containers and that fulfillment of a customer order includes partially filling one

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

of the standard volume containers. Liquids are normally measured by volume. ... it makes sense to only partially fill one of the standard volume containers ... Thus, one (of) ordinary skill in the art would know to disclose that liquid products are containerized in standard volume containers and that fulfillment of a customer order may include partially filling one of the standard volume containers";

are overcome by the observation that there is at least one very good reason why partial filling of paint cans is unknown in the prior art: the paint is priced according to units comprised only by full containers; and therefore the alteration in pricing enabled by internet ordering of liquid coating product produces an unexpected result: the feasibility of partial filling of containers in fulfillment of an order for liquid coating product.

11. Applicant respectfully submits that Examiner's statement: "As per claims 4-6, DISTRIBUTOR ROLES discloses the method of claim 1 for home improvement products" (FOA, page 11, second paragraph) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph) and the presently claimed method is restricted to a "method for the direct supply for containerized liquid coating product inclusive of a plurality of particular, [non-standard] custom, colors by a supplier remote from a consumer" (Claim 1, lines 1 - 2).

12. Applicant respectfully submits that Examiner clearly states in the first Office action that "DISTRIBUTOR ROLES does not disclose ... liquid product ... containerized in non-standard volume expandible containers (or) molded plastic construction (or) a collar about an aperture ... gripped during operation of the production line" (FOA page 11, second paragraph).

13. Applicant respectfully submits, with regard to the rejection of present claims 4 - 6 conveyed in the first Office action quoted above in B.11, that Examiner's statement given in support of said rejection:

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to disclose that the liquid product is containerized in nonstandard volume expandable containers, that the expandable containers are of molded plastic construction and the expandable containers possess a collar about an aperture whose collar is gripped during operation of the production line. (FOA, page 11, third paragraph)

does not provide any reason as to why 'it would have obvious', contains no reference to any prior art, and that the four paragraphs following (FOA page 11, fourth paragraph through page 13, second paragraph) similarly contain no reference to any prior art indicating that the presently claimed subject matter in claims 4 - 6 would have been obvious in view thereof.

14. Applicant respectfully reviews the four paragraphs following the above quoted statement given in support of the rejection of present claims 4 - 6 conveyed in the first Office action in support of the submission above that said four paragraphs contain no reference to any prior art:

One of ordinary skill ... would have been motivated to disclose (liquid coating product containerized in non-standard, expandable molded plastic containers with a collar) for the obvious reason that manufacture and distribution of may liquid coating products is often regulated by government entities ... Heavier liquid coating materials would normally require thicker plastic containers, collapsible or rigid, than lighter liquid coating materials. (FOA, pages 12 - 13)

One of ordinary skill in the art would know that higher volumes may require sturdier containers ... shipping is often based on weight ... rigid metal containers would probably weigh more than their plastic equivalents ... Collapsible plastic containers would most likely weigh less than rigid walled plastic containers.

One of ordinary skill in the art would know that bottling a liquid is best accomplished ... Additionally, gripping a container by a collar facilitates placement of a sealing top on the container. (FOA, page 13, second paragraph)

It would have been obvious to one of ordinary skill in the art that, where possible, it makes economic sense to use collapsible plastic containers ... Better natural resource use and allocation also permits less contamination and provides everyone on the planet with a healthier environment. (FOA, page 13, third paragraph)

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

and respectfully submits that this material comprises: a general reference to regulation by government entities; speculation: i.e. 'would know', 'would probably know', 'would probably weigh more', 'would likely weigh less'; and conjecture: 'it makes sense'; which are unsupportive of rejection.

15. Applicant respectfully submits that Examiner's statement: "As per claims 7-10, DISTRIBUTOR ROLES discloses the methods of claim 1 of identifying products for assembly and delivery" (FOA, page 13, third paragraph) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph) and the presently claimed method, singular, is restricted to a "method for the direct supply for containerized liquid coating product inclusive of a plurality of particular, non-standard, colors by a supplier remote from a consumer" (Claim 1, lines 1 - 2).

16. Applicant respectfully submits that Examiner is on record as stating that "DISTRIBUTOR ROLES does not":

- a. "disclose which data (are) selected for print on the label of a container";
- b. "use the words 'digital code readable by a scanner'";
- c. "state that the information on a container may include at least one of the group comprised of color of liquid coating product, customer name, delivery date, quantity of product in order, number of containers for each liquid coating product in the order." (FOA pages 13 - 14)

17. Applicant respectfully submits that the reasons given in support of the rejection of present claims 7 - 10 conveyed in the first Office action are unsupportive of rejection in lacking any reference to containerized liquid coatings or the data presently claimed for inclusion on a label for a container of liquid coating product attributed to the prior art.

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

18. Applicant respectfully submits that the statement "One would want to automate the method ... for the obvious reason that it avoids confusion (and is more efficient)" (FOA, page 15, first paragraph) effectively begs the question of whether the presently claimed subject matter is obvious in view of the prior art: even if one would have wanted to automate a given method the question of whether the presently claimed means of achieving that automation was disclosed or suggested or otherwise rendered obvious by the prior art is simply not addressed.
19. Applicant respectfully submits that Examiner's rejection of present claims 11 - 16: "As per claims 11-16, DISTRIBUTOR ROLES discloses that home improvement products may be sold in bulk from a manufacturer to a distributor, and even from a manufacturer to a customer" and that "Home improvement products include liquid coating products" (FOA, page 15, second paragraph) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph) and "does not disclose that home improvement products may include liquid coating products" (FOA, page 10, first paragraph) while the presently claimed method is restricted to a "method for the direct supply for containerized liquid coating product inclusive of a plurality of particular, non-standard, colors by a supplier remote from a consumer" (Claim 1, lines 1 - 2).
20. Applicant respectfully submits that Examiner clearly states in the first Office action that "DISTRIBUTOR ROLES does not specifically describe the process of adding blended liquid coating base to an empty container." (FOA page 15, third paragraph).
21. Applicant respectfully submits that Examiner's statement that "While DISTRIBUTOR ROLES discloses that manufacturers may ship liquid home improvement products directly to distributors and customers in containers" (FOA page 15, third paragraph) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

coatings" (FOA, page 8, second paragraph).

22. Applicant respectfully submits that the rejection of present claims 17 - 22 conveyed in the first Office action (pages 18 - 19) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph) and the presently claimed method is restricted to a "method for the direct supply for containerized liquid coating product inclusive of a plurality of particular, non-standard, colors by a supplier remote from a consumer" (Claim 1, lines 1 - 2).

23. Applicant respectfully submits that the rejection of present claims 23 & 24: "As per claim 23-24, DISTRIBUTOR ROLES discloses that the step of placing an order by a customer directly with a remote supplier of liquid coating product is conducted with the use of the Internet" (FOA, page 20, first paragraph) is in error because DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph).

24. Applicant respectfully submits that the rejection of present claims 25 - 28: "As per claim 25-28, DISTRIBUTOR ROLES discloses the method of claim 24 wherein the step of placing an order by a customer directly with a remote supplier of liquid coating product is conducted with the use of a dedicated terminal with internet access" (FOA, page 20, last paragraph) is in error because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph).

25. Applicant respectfully submits, with regard to the rejection of present claims 29 - 34, "As per claims 29-34, DISTRIBUTOR ROLES discloses the use of the Internet and electronic commerce ... to allow customers to order home improvement products" (FOA, page 22, last paragraph), Examiner clearly states that:

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

DISTRIBUTOR ROLES does not describe include (sic) plurality of standard and non-standard colors (claim 29), specific characteristics (claim 30) of liquid coating products according to job specifications (claim 31), recommendation of liquid coating base (claim 32), volume calculation per user input (claim 33), or that customer input may include digital video, photograph or digital solid modeling (claim 34). (FOA, page 22, last paragraph)

26. Applicant respectfully submits that the statement given in support of rejection of present claims 29 - 34: "Nevertheless, it would have been obvious ... to include ... (claim 29) ... (claim 30) ... (claim 31) ... (claim 32) ... (claim 33) ... (claim 34)" (FOA, page 23, first paragraph) constitutes a repetition of presently claimed features clearly stated by Examiner as being undisclosed by the only prior art reference cited in support of rejection.

27. Applicant respectfully submits that the reason given in support of rejection of present claims 29 - 34: One ... would have been motivated to include ... (claim 29) ... (claim 30) ... (claim 31) ... (claim 32) ... (claim 33) ... (claim 34) ... for the obvious reason that these are normal considerations when selecting liquid coating product bases and colors" (FOA, page 23, second paragraph) is rendered moot by Examiner's admission that "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph) and that the balance of the support given in rejection of present claims 29 - 34 constitutes conjecture and speculation without any reference to the prior art:

It is obvious that different customers have different requirements. For example, a customer who wishes ... would have different needs from an industrial customer who wishes... Similarly, architectural customers have different needs (than) customers who order liquid coating products for use to coat the bottom of a yacht, or to coat the outside of a train or ... Thus, one .. would have known to include steps to facilitate customer selections and include ... One ... also would have known that since customers have specific needs, a web site might also include ... One ... would know

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

that (CAD/CAM) systems have been widely used ... Thus, it would have been obvious to include similar technology ... for other uses. (FOA, pages 23 - 24);

and is hence unsupportive of rejection as obvious in view of the prior art.

C. Distinguishment Over the Prior Art

1. Applicant respectfully submits that the presently claimed invention is patentably distinguished over the prior art cited in the first Office action by the language of base claim 1 clearly expressing that said invention is a "business method for the direct supply for containerized liquid coating product" (Line 1) while Examiner is clearly on record as admitting that "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph).

2. Applicant respectfully submits that the presently claimed invention is patentably distinguished over the prior art cited in the first Office action by the language of base claim 1 clearly expressing that said invention includes:
 - a. "a plurality of particular, [non-standard] custom, colors" (Line 2);
 - b. "specifying customer order information including indication of at least one liquid coating base" (Line 5)
 - c. "specifying customer order information including indication of ... a color" (Line 5);
 - d. "a customer order subsystem comprised of software maintained on a computer" (Lines 7 - 8);
 - e. "compiling said customer order information with a computer and processing the results of this compilation with a production subsystem to yield production parameters"; (Lines 9 - 10);
 - f. "operating ... a containerized liquid coating production line" (Lines 11 - 12);

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

- g. "assembling containerized liquid coating product" (Line 15);
- h. "transporting each said assemblage of containerized liquid coating product" (Line 18);
- i. "delivery of containerized liquid coating product" (Line 20);

which nine elements are all absent from the cited prior art because "DISTRIBUTOR ROLES does not disclose ordering, production, packaging and delivery of liquid coatings" (FOA, page 8, second paragraph).

3. Applicant respectfully submits, in accordance with 37 CFR 1.11(b), that the language of present base claim 1 patentably distinguishes the presently claimed invention over the prior art cited in the first Office action by restricting said invention to "containerized liquid coating product" including a plurality of elements each specific to "containerized liquid coating product" which are wholly absent from the reference cited in rejection.
4. Applicant respectfully submits, in accordance with 37 CFR 1.11(c), that the patentable novelty presented by the present claims in view of the prior art is a method for "the direct supply for containerized liquid coating product ... by a supplier remote from a customer" (Claim 1, lines 1 - 2) inclusive of a plurality of steps particular to containerized liquid coating product identified in paragraph C.2. above.

D. Summary and Request for Allowance

1. Applicant respectfully submits that this response has been timely filed.
2. Applicant respectfully submits that Amendment A, attached hereto, meets all the objections to the specification by correcting all informalities of language therein.

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

3. Applicant respectfully submits that Amendment A, attached hereto, overcomes all objections/rejections of the present claims under 35 U.S.C. 112 conveyed in the first Office action by eliminating all indefinite language in said claims and providing proper antecedent basis for all terms therein.
4. Applicant respectfully submits that all the grounds of rejection of present base claim 1 conveyed in the first Office action have been overcome by the demonstration above that said claim is restricted to "containerized liquid coating product" including a plurality of elements each specific to "containerized liquid coating product" which are, by Examiner's admission, undisclosed by the only reference cited in rejection.
5. Applicant respectfully submits that all the grounds of rejection of present base claim 1 conveyed in the first Office action have been overcome by the demonstration above that Examiner's reasons given in support of said rejection lack any reference to the prior art and hence can not constitute evidence of disclosure, suggestion, or rendering obvious the presently claimed invention by the prior art.
6. Applicant respectfully submits that all the grounds of rejection of present claim 1 conveyed in the first Office action have been overcome by the demonstration above that Examiner's statement that one of ordinary skill in the art "would know that by including liquid coatings among their products and services" benefits would be obtained constitutes an affirmation that the presently claimed invention is unobvious in view of the prior art because said invention is by Examiner's admission undisclosed by the cited prior art despite the fact benefits resulting from the same were known.
7. Applicant respectfully submits that all the grounds of rejection of present claim 1 conveyed in the first Office action have been overcome by the demonstration above that Examiner states that

Application No. 09/543,764
Inventor: John L. Howes

Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

the only reference cited in rejection of the presently claimed invention under 35 U.S.C. 103 conveyed in the first Office action "does not disclose that home improvement products may include liquid coating products" (FOA, page 10, first paragraph).

8. Applicant respectfully submits that all the grounds of rejection of present claim 1 conveyed in the first Office action have been overcome by the demonstration above that Examiner's statement that one of ordinary skill: "would have been motivated to disclose that home improvement products may include liquid coating products ..." fails to provide any attribution to the prior art for being motivated to include liquid coating products.
9. Applicant respectfully submits that present claims 2 - 4 & 6 - 34 are properly dependent upon present base claim 1 in each specifying a further restriction upon the method claimed therein and hence if present claim 1 is allowable then present claims 2 - 4 & 6 - 34 are allowable.
10. Applicant respectfully submits that the rejections of present claims 2 - 4 & 6 - 34 conveyed in the first Office action are overcome by the demonstration above that the reasons given in support of said rejections fail to reference the prior art cited in rejection.
11. Applicant respectfully submits that each point made by Examiner in the first Office action has been properly rebutted in the present response.
12. Applicant respectfully submits that Amendment A, attached hereto, neither enlarges the scope of the claims nor adds new matter to the specification as filed.
13. Applicant respectfully submits that the amendment made herewith corrects language informalities only and does not amend to overcome grounds of rejection relating to the prior art.

Application No. 09/543,764
Inventor: John L. Howes

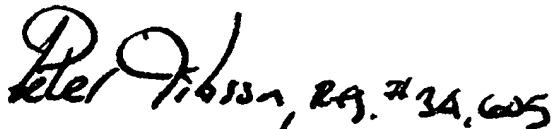
Art Unit 2165

Examiner: James H. Zurita
Filed: 5 April 2000

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

14. Applicant respectfully submits, for all of the reasons presented above, that the present application is in full and proper condition for allowance which action is further respectfully and humbly requested.

Respectfully yours,

A handwritten signature in black ink that reads "Peter Gibson, Reg. #34,605". The signature is fluid and cursive, with "Peter" and "Gibson" connected at the top, and "Reg." and "#34,605" written below in a slightly smaller script.

Peter Gibson, Reg. #34,605
Tel. 410/358-5912; Fax -9636